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| 09/102,207      | 06/22/1998  | DAVE GOH             | 10971798-1          | 1530             |

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FORT COLLINS, CO 80527-2400

EXAMINER

DAVIS, DAVID DONALD

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2652

DATE MAILED: 07/01/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

gm

# Office Action Summary

Application No.

09/102,207

Applicant(s)

GOH ET AL.

Examiner

David D. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 31-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

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***Election/Restrictions***

1. Claims 31-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 10, received November 15, 2001.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-15 and 21-30 rejected under 35 U.S.C. 102(e) as being anticipated by Beaudoin et al (US 6,400,715). Figure 1 of Beaudoin et al shows chip 200 for incorporation within a network device connectable to a computer network. The network device includes a host processor. Chip 200 includes media access controller (MAC) 120 connectable to the computer network. MAC 120 provide the chip with access to the computer network independent fo the host processor, as stated in column 14, line 37 through column 15, line 20. Column 14, line 37 through column 15, line 20 also states that there is an embedded processor within chip 200 since there is not need for an external CPU.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102((e), f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaudoin et al (US 6,400,715) in view of Han (US 5,903,737). Beaudoin et al discloses the claimed invention. However, Beaudoin et al is silent as to the interchip communication including an I<sup>2</sup>C bus with the compliant device being an I<sup>2</sup>C-compliant device.

Han discloses in column 2, lines 58-67 I<sup>2</sup>C serial data communications.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the apparatus of Beaudoin et al with I<sup>2</sup>C serial data communications as taught by Han. The rationale is as follows: one of ordinary skill in the art at

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the time the invention was made would have been motivated to provide I<sup>2</sup>C serial data communications so as to provide an apparatus “which can transmit and receive serial data of an inter integrated circuit (IIC or I<sup>2</sup>C) type utilizing a general microcomputer.” See column 1, lines 6-12 of Han..

7. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaudoin et al (US 6,400,715). Beaudoin et al discloses the claimed invention. However, Azarya et al is silent as to specific memory types (e.g. non-volatile and/or volatile).

Official notice is taken of the fact that volatile and non-volatile memory types are notoriously old and well known in the computer/network art.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to specify the memory types for the apparatus of Beaudoin et al as taught in the art. The rationale is as follows: one of ordinary skill in the art at the time the invention was made would have been motivated to specify memory types to provide cost and manufacturing flexibility in the procurement of the memory.

#### ***Response to Arguments***

8. Applicant's arguments filed April 21, 2003 have been fully considered but they are not persuasive. Applicant asserts in the paragraph bridging pages 4 and 5, for example, that Beaudoin does not disclose “an embedded processor, but only indicates that there is no need for an external CPU”. It should be noted that CPU is an acronym for central **processing** unit. If there is not need for external processor in Beaudoin, then an absence of an external processor

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indicates that Beaudoin discloses a processor on single chip 200, as required by the claims.

Furthermore, Beaudoin states that control, logic and communications are performed by the processes in the single chip, which is not unlike the embedded processor claimed in the instant application.

In the second full paragraph on page 5, for example, applicant states “nothing in Beaudoin could be [taken] to infer, for example, that any embedded process within circuit 200 would be programmable to function as a manageability web server”. The manageability web server, as claimed, communicates with the host interface, the processor of Beaudoin shows this in the figure 1 by way of the bi-directional arrows pointing inside single chip 200 and outside single chip 200. The manageability web server, as claimed, obtains manageability about the network device. The processor of Beaudoin shows this in the figure 1 by way of the network blocks. The manageability web server, as claimed, sends manageability information to the media access controller. The processor of Beaudoin shows this in the figure 1 by way of the bi-directional arrows to and from the MAC blocks.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

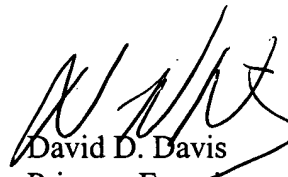
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Davis whose telephone number is (703) 308-1503. The examiner can normally be reached on Mon., Tues., Thurs. and Fri. between 7:30-6:00. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900. Any other inquiry should be directed to the customer service center whose telephone number is (703) 306-0377.



David D. Davis  
Primary Examiner  
Art Unit 2652

ddd  
June 29, 2003